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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/853,827      | 05/11/2001  | Alex Lang            | 4989-009            | 6461             |

27820 7590 05/04/2005

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| EXAMINER |
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HOFFMAN, BRANDON S

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| ART UNIT | PAPER NUMBER |
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2136

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/853,827 | <b>Applicant(s)</b><br>LANG ET AL. |  |
|                              | <b>Examiner</b><br>Brandon Hoffman   | <b>Art Unit</b><br>2136            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-28-05</u> | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

1. Claim 1-23 are pending in this office action.
2. Applicant's arguments, filed March 7, 2005, have been fully considered and are persuasive.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klemba et al. (U.S. Patent No. 6,123,456).

Regarding claims 1, 13, and 23, Klemba et al. teaches a portable device for engaging a host computing device comprising:

- A body (fig. 2, ref. num 12);
- A memory within the body containing (col. 2, lines 45-47):
  - Initial identification indicia to initially identify the portable device to the host computing device as a first device type in which a driver for the first device

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- type is known to the host computing device (col. 10, lines 43-49, without the policy, the CU provides simple capabilities, such as card reading); and
- Software instructions to subsequently identify the portable device as a cryptographic service provider/second device type to the host computing device and provide a driver for the cryptographic service provider to allow the host computing device to effectively interact with the portable device to provide cryptography services for applications running on the host computing system (col. 2, lines 53-54, col. 3, lines 2-4, and col. 3, lines 23-27); and
  - An interface associated with the memory and adapted to facilitate interaction with the host computing device (fig. 2, ref. num 20/28 and fig. 3, ref. num 35/36),
    - Wherein the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the portable device to provide the cryptography services for the applications running on the host computing device (col. 2, lines 53-54, col. 3, lines 2-4/23-27, and col. 10, lines 43-49).

Klemba et al. does not specifically teach the cited body (NFC 12) as having both the first device type and the cryptographic service provider/second device type.

However, alternate embodiments can be applied to the NFC 12 and are within the scope of the invention. For example, the NFC (being a smart card like device) can contain a substantial amount of storage and would therefore be recognized as a storage device, or first device type. The NFC also has the cryptographic policy, which makes

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the NFC a cryptographic service provider. Another embodiment is the NFC and CU can be combined into one unit. This would mean the CU would have card reading abilities, such as a smart card or storage device. The CU would also have cryptographic abilities, such as those provided by the NFC.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Klemba et al. to contain both the first device type and the cryptographic service provider/second device type all on one body. It would have been obvious for such modifications because combining processes/circuits onto one device lowers the overall cost and increases processing speed.

Regarding claim 2, Klemba et al. as modified teaches wherein the memory further contains service indicia providing instructions to provide a service corresponding the second device type (col. 7, lines 14-15).

Regarding claims 3 and 14, Klemba et al. as modified teaches wherein the service indicia includes instructions for the host computing device to provide the service for applications running on the host computing device (col. 3, lines 23-27).

Regarding claims 4 and 16, Klemba et al. as modified teaches further comprising a processing unit associated with said memory and wherein the service indicia includes **configuration** instructions for said processing unit to provide the cryptography service

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for the host computing device (fig. 2, ref. num 26, col. 2, lines 53-54, and col. 3, lines 12-14).

Regarding claim 5, Klemba et al. as modified teaches wherein the configuration indicia includes a file executable on the host computing device to reconfigure the host computing device to recognize and interact with the portable device as the second device type (col. 7, lines 14-15).

Regarding claim 6, Klemba et al. as modified teaches wherein the memory further contains an application to run on the host computing device (col. 2, lines 31-35).

Regarding claims 7 and 18, Klemba et al. as modified teaches wherein the first device type is a storage device (col. 10, lines 43-46).

Regarding claims 8 and 19, Klemba et al. as modified teaches wherein the second device type is a cryptographic service provider (col. 3, lines 1-14).

Regarding claim 9, Klemba et al. as modified teaches wherein said memory further contains at least one of the group consisting of private cryptography key, public cryptography key, and cryptography algorithm (col. 3, lines 6-10).

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Regarding claim 10, Klemba et al. as modified teaches wherein the interface is one of the group consisting of electrical, optical, and radio frequency (col. 7, lines 25-34 and col. 9, lines 10-18).

Regarding claims 11 and 20, Klemba et al. as modified teaches wherein the memory further contains deregistering indicia providing instructions for the host computing device to reconfigure the host computing device to a configuration state prior to interacting with the portable device (col. 7, lines 7-10).

Regarding claims 12 and 21, Klemba et al. as modified teaches wherein the memory further contains cleansing indicia providing instructions for the host computing device to remove at least certain information from the host computing device indicative of use of the host computing device while associated with the portable device (col. 7, lines 7-10).

Regarding claim 15, Klemba et al. as modified teaches wherein the **configuration** instructions to provide the cryptography services are configured for running on the host computing device (col. 3, lines 15-27).

Regarding claims 17 and 22, Klemba et al. as modified teaches a method comprising:

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- Identifying a portable device to a host computing device as a first device type, which is known to the host computing device (col. 10, lines 43-46, without the policy, the CU provides simple capabilities, such as card reading);
- Registering the portable device with the host computing device as the first device type (col. 10, lines 46-49);
- Automatically identifying the portable device to the host computing device as a cryptographic service provider/second device type (Examiner believes it to be inherent that the portable device is automatically identified because the CU, which is illustrated as a PCMCIA card, is automatically detected by the host device upon insertion);
- Enabling the portable device as the cryptographic service provider/second device type with the host computing device based on information provided on the portable device (col. 2, lines 53-54 and col. 3, lines 2-4); and
- Providing cryptography services for applications running on the host computing device based on **the** information provided by the portable device (col. 3, lines 23-27).

Klemba et al. does not specifically teach the cited portable device (NFC 12) as having both the first device type and the cryptographic service provider/second device type. However, alternate embodiments can be applied to the portable device (NFC 12) and are within the scope of the invention. For example, the NFC (being a smart card like device) can contain a substantial amount of storage and would therefore be recognized as a storage device, or first device type. The NFC also has the



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cryptographic policy, which makes the NFC a cryptographic service provider. Another embodiment is the NFC and CU can be combined into one unit. This would mean the CU would have card reading abilities, such as a smart card or storage device. The CU would also have cryptographic abilities, such as those provided by the NFC.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Klemba et al. to contain both the first device type and the cryptographic service provider/second device type all on one body. It would have been obvious for such modifications because combining processes/circuits onto one device lowers the overall cost and increases processing speed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Branda Riff*  
BH

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